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Docket No. 0624-4129

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Laurence C. Mudge

Group Art Unit: 1616

Serial No.: 10/849,509

Examiner: Alton N. Pryor

Filed: May 19, 2004

For: FUNGICIDAL COMPOSITIONS FOR THE ENHANCEMENT OF TURF QUALITY

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Docket No. 0624-4129

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue of: U.S. Patent No. 5,599,804

Inventor: Laurence C. Mudge

Serial No.: 10/849,509

Group Art Unit: 1616

Filed: May 19, 2004

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SIR:

REQUEST FOR RECONSIDERATION

This communication responds to the Office Action dated February 2, 2005. This response is timely filed in view of the accompanying "Petition and Fee for Extension of Time," which requests the appropriate extension of time.

Applicant expresses his appreciation to the Examiner for his courtesy in conducting a telephone conference on May 2, 2006, with applicant's attorneys Richard Henderson and the undersigned. During the interview the prosecution of the reissue application and the rationale for the present rejection were reviewed. The Hoechst published abstract and Fenn et al. publication were discussed. This communication incorporates the discussion held during the interview. Without making any commitments, the Examiner indicated that a communication containing the points discussed during the interview would be responsive to the outstanding rejection and would cause a reconsideration of the rejections.

All of the method claims (claims 1-8, 22 and 24-31) have been allowed. Only the composition claims 10-17, 20, 21, 23, 32-35, 37 and 38 have been rejected under 35 U.S.C. § 103, as being obvious to a person of ordinary skill in the art based on the combination of the Hoechst published abstract and the Fenn et al. publication. The obviousness rejection is based upon the following rationale for motivating a person of ordinary skill in the art to combine and modify the references:

“It would have been obvious to modify the composition taught by Hoechst to include the phosphorous acid or fosetyl-Al taught by Fenn. One would have been motivated to do this since both references individually teach fungicidal compositions.”

There is no affirmative teaching in the art which provides a basis to pick and choose these two specific references, with their differently described fungicidal compositions, for combination in the manner suggested in the office action. Moreover, even assuming *arguendo* that the references could be combined, the combined teachings of these references would not result in a composition of the present claims. The composition claims require a composition “wherein the active material present in synergistic fungicidally effective amounts consists essentially of” a component “(a)” which is an active agent selected from phosphorous acid, certain salts thereof and certain monoester salts of a phosphorous acid such as fosetyl Al and a component “(b)” which is a phthalocyanine.

The Hoechst reference does not disclose any phthalocyanine compound as a compound possessing any fungicidal properties or as a promoter of the fungicidal properties of any other fungicidally active compound. The Hoechst reference describes a very limited purpose for phthalocyanine, to inhibit crystal growth in stored dispersions containing 2-alkyl-4,6-dinitrophenol esters:

Aq. Dispersions of 2-alkyl-4,6-dinitrophenol esters (I) contain as *stabiliser* 0.1-3 (pref. 0.3-1) wt. % of a metal complex dye (II) of the azo or phthalocyanine series. The dispersions are used as fungicides and /ro [sic] acaricides or herbicides. Presence of (II) [azo or phthalocyanine series] *prevents the crystal growth* normally occurring on storage of such dispersions (e.g. a dispersion contg. <10mµ crystals normally contains crystals up to 50µ long after 2-3 months), *which leads to decrease of biological activity*. [Emphasis added]

In the Hoechst composition, the phthalocyanine component has a very limited function and purpose: to prevent crystal growth of the 2-alkyl-4,6-dinitrophenol esters when it is stored as an aqueous dispersion. The growth of the crystals decreases the biological activity of the dinitrophenol esters. Hence, the phthalocyanine prevents the crystal growth which in turn prevents any decrease in the biological activity of the dinitrophenol esters. This is very different from phthalocyanine functioning to increase the fungicidal activity of another active ingredient.

In contrast to the Hoechst dispersion, the Fenn etal. article describes antifungal compositions as an “aqueous solution of fosetyl-Al...or H₃PO₃...” [emphasis added] See Fenn etal, in sentence bridging the columns on page 1. There exists no motivation for a person of ordinary skill in the art to combine these very different formulations (dispersions and solutions) and such chemically different active ingredients. Moreover, the 2-alkyl-4,6-dinitrophenol esters of Hoechst are very different in chemistry from, for example, the inorganic phosphorous acid and its salts and fosetyl-Al components in Fenn etal.

Also, the examiner's suggestion in the office action of mixing Hoechst's dispersion of phthalocyanine and 2-alkyl-4,6-dinitrophenol esters with the Fenn etal. aqueous solution of fosetyl-Al or H₃PO₃, merely because they are both described as being “fungicidal” does not provide a motivation to include *phthalocyanine* in any combined composition. Phthalocyanine is only suggested by Hoechst as a crystal inhibitor when 2-alkyl-4,6-dinitrophenol ester is stored as an aqueous dispersion.

Additionally, the Hoechst reference provides no affirmative teaching or suggestion to add phthalocyanine, with its crystal growth inhibiting properties, to a fungicide composition as described in Fenn et al.

The present composition claims have been carefully worded. For example, claim 10 defines the "active material" that is "present in synergistic fungicidally effective amounts" in the composition to be "selected from the group which consists essentially of" two members "(a)" and "(b)". Member (a) is a first active agent which is either a monoester salt of a phosphorous acid or phosphorous acid or certain salts thereof. The "(b)" member is a phthalocyanine compound. This language contemplates that the mixture of the members "a" and "b" will provide "synergistic fungicidally effective" properties. These features of the composition claims are not suggested by either of the two cited references. The Hoechst reference only describes phthalocyanine to control or limit crystal growth of 2-alkyl-4,6-dinitrophenol esters and not to possess or promote fungicidal properties. Hence, according to the Hoechst reference, in the presence of phthalocyanine, the 2-alkyl-4,6-dinitrophenol ester will retain its fungicidal properties, not increase them.

CONCLUSION:

The pending composition claims 10-17, 20, 21, 23, 32-35, 37 and 38 are patentable and an early action allowing these composition claims in addition to the previously allowed method claims is respectfully solicited. The undersigned attorney invites the opportunity to discuss any matter with the examiner which can expedite the prosecution of this application.



Respectfully submitted,

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Dated: June 2, 2006

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